

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:

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PCT

WRITTEN OPINION
(PCT Rule 66)

Date of mailing (day/month/year) 03.03.2004	
Applicant's or agent's file reference HARD1.063VPC	REPLY DUE within 3 month(s) from the above date of mailing
International application No. PCT/AUS 03/22656	International filing date (day/month/year) 16.07.2003
Priority date (day/month/year) 16.07.2002	
International Patent Classification (IPC) or both national classification and IPC B32B13/02	
Applicant JAMES HARDIE RESEARCH PTY. LIMITED et al	

1. This written opinion is the **first** drawn up by this International Preliminary Examining Authority.
2. This opinion contains indications relating to the following items:
 - I ☒ Basis of the opinion
 - II ☐ Priority
 - III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - IV ☐ Lack of unity of invention
 - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - VI ☐ Certain documents cited
 - VII ☐ Certain defects in the international application
 - VIII ☐ Certain observations on the international application
3. The applicant is hereby invited to reply to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also: For an additional opportunity to submit amendments, see Rule 66.4.
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.
4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: **16.11.2004**

Name and mailing address of the international preliminary examining authority:



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WRITTEN OPINION

International application No. PCT/US 03/22656

I. Basis of the opinion

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed"*):

Description, Pages

1-13 as originally filed

Claims, Numbers

1-70 as originally filed

Drawings, Sheets

1/7-7/7 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

5. ☐ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

6. Additional observations, if necessary:

V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**1. Statement**

Novelty (N)	Claims	1-70
Inventive step (IS)	Claims	1-70
Industrial applicability (IA)	Claims	1-70

2. Citations and explanations**see separate sheet**

Prior art:

- D1: WO 95 11357 A (SEAL COSTRUZIONI S R L ;VALENTE CORRADO (IT)) 27 April 1995 (1995-04-27)
D2: DE 199 38 806 A (SCHULTZE KRAFT ANDREAS) 22 February 2001 (2001-02-22)
D3: US-A-5 397 631 (GREEN GEORGE W ET AL) 14 March 1995 (1995-03-14)
D4: WO 97 19810 A (NESITE S R L) 5 June 1997 (1997-06-05)

Multiple independent claims:

An essential point for the Examining Authority, either in the international or regional European phase is the limitation of the number of independent claims in one category. Accordingly, in the present case a lack of clarity with regard to the claimed subject-matter arises from the number of independent product claims 1, 18, 43 and method claims.

Independent claim 1:

Analyses of features:

- fiber cement product (D1, Fig. sheet 1/1),
- finish layer (D1, reference signs 2 or 3),
- further layer (D1, reference signs 3 or 4).

Accordingly, the subject-matter of claim 1 lacks novelty over the disclosure of document D1.

Present claim 1 refers to a number of items which do not contain any information how the desired effect is achieved. By contrast, the protective layer is said to protect the finish layer from damage in storage, transport, and handling. However, no feature in claim 1 may be examined and it remains unclear from the wording of this claim which characteristic may be responsible for the protecting effect.

The same situation arises from the fact the protective layer resists tearing on removal and that no residue rests on the finish layer when removing the protective layer.

Accordingly, few items remaining in claim 1, as analysed above. The subject-matter of claim 1 therefore lacks novelty. Corresponding problems arising from further claims 18, 23, 26, 43 and 56.

Further dependent claims:

Claims 2 to 5 deal with adhesives and their characteristics. To those skilled in the art D4 shows the use of various adhesives in connection with cement and polymeric fibers wherein layers are bonded with an adhesive layer.

Claims 6, 7, 8 refer to a protective prefinished fiber cement product of claim 1, wherein the protective layer comprises a polymeric film. Such polymeric film is disclosed from document D2, col. 6, claims 1 and 2, wherein a polyester is used for the finish of a fiber cement product. The use of polyethylene according to claim 8 appears also to be rendered obvious from this disclosure.

Dependent claims 9 to 17 refer to constructional variations and appear to be obvious to those skilled in the art.

All further independent claims:

All further independent claims refer essentially to the same items as already dealt with under the point referring to claim 1. Accordingly, those claims shall also be considered as being not novel over the disclosure of document D1.

The assembly according to claim 18 appears also to be common knowledge to those skilled in the art since the stack of a plurality of plates is a common method of storage such elements.

Accordingly, therefrom dependent claims lack the same deficiencies as claims 2 to 17 already analysed above.

**WRITTEN OPINION
SEPARATE SHEET**

International application No. PCT/US03/22656

Reference signs:

The present set of claims is not accompanied with reference signs. Accordingly, the understanding of the present subject-matter is complicated. When entering the European regional phase reference signs should be joined to the corresponding characteristics.

Spirit and scope of the present application page 13, last paragraph:

If the European regional phase is entered such paragraph should be deleted from the description.